

Appln No.: 09/682,723
Amendment Dated: September 22, 2003
Reply to Office Action of March 20, 2003

REMARKS/ARGUMENTS

This is in response to the Office Action mailed March 20, 2003 for the above-captioned application. Reconsideration and further examination are respectfully requested.

Applicants request an extension of time to make this paper timely and enclose the fee. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 07-0862.

Claim 46 has been amended to correct a clerical error.

The Examiner made a provisional double-patenting rejection based on US Patent Application No. 10/268,395. A power of attorney for the undersigned has been filed in Serial No. 10/268,395, and amendments will be made in that case to eliminate the duplicate claims.

The Examiner rejected claims 1-39 under 35 USC § 102(b) as anticipated by EP 0764673 or EP 0360578. Applicants respectfully point out that anticipation requires the presence of each and every element of the claimed invention, either expressly or inherently, in a single reference, and further that the burden is with the Examiner to show how the reference meets the limitations of the claims. Applicants submit that the Examiner has not met this burden, since there is no identification of the teaching of the references which supposedly meets the limitations of the claims.

Claim 1 relates to a method of producing a polycarbonate in which an end-capping agent is added. Claim 39 relates to the end-capping agent as a composition. In each case, the end-capping agent comprises: (a) at least one species of a symmetrical activated aromatic carbonate, and (b) at least one species of an optionally-substituted phenol. In the description of the cited European patent applications, the Examiner has not identified the materials which she asserts meet the description of the end-capping agent as defined in the present claims. In fact, the Examiner has merely reproduced, *verbatim*, the abstracts of the two European patent applications. Applicants can find no justification for the rejection in either reference. Thus, it is submitted that the rejection should be withdrawn, or explained in appropriate detail what part of the disclosure the Examiner contends meets the limitations of the instant claims.

The Examiner rejected claims 1-34 as anticipated by US Patent No. 6,525,163. In this case, the Examiner apparently argues that the end-capping of structures 1 and 2 of the reference meets the limitations of the present claims. However, no formula's are identified as structures 1 and 2, so it is not clear what the Examiner is referring to. Applicants do point out that the end-

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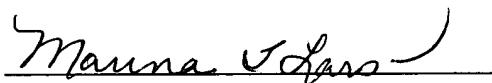
capping agent described in the '163 patent has the formula shown in Col. 3, and that this is neither a symmetrical activated aromatic carbonate nor a phenol, and most particularly is not both. This being the case, the basis for the rejection of the claims 1-34 is not understood, and the rejection should be withdrawn or clarified.

The Examiner rejected claims 1-34 as anticipated by US Patent No. 6,500,914. The Examiner has not explained how this patent can be prior art under any section of 35 USC § 102, since it shares a common filing date with the present application. Furthermore, the Examiner in making the rejection has equated a "symmetrical non-activated aromatic carbonate" which is what is disclosed in the '914 patent, with an "optionally-substituted phenol" which is what is required in the instant claims. The Examiner has not explained why this is appropriate, or why a person skilled in the art might view the one as inherently disclosing the other. Thus, the rejection based on this patent is not understood and the rejection should be withdrawn or clarified.

Finally, the Examiner states that claims 40-47 are objected to for being dependent upon rejected claims 1-14 and would be allowable if rewritten in independent form. While Applicants appreciate the indication of allowable subject matter, it is noted that claims 40-47 depend only on claim 39 and each other and not on claims 1-14 as indicated. If the electronically filed application states otherwise, Applicants request immediate notification so that a corrective document can be filed. Applicants would further note that claims dependent on claim 1 with the same limitations as claim 40-47 are found in method claims 5, 13-15, 20-21 and 23-24. Thus, it is not understood how these claims could be rejected as anticipated when claims 40-47 are indicated to be allowable.

In view of the foregoing, Applicants submit that this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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